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EXAMINER

BATTULA, PRADEEP CHOUDARY

ART UNIT

PAPER NUMBER

3725

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/607,233	Applicant(s) BLOHM ET AL.	
	Examiner PRADEEP C. BATTULA	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 28-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 28-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in reply to the response filed on February 26, 2008

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 3, 4, 6, 9, 10, 11, 13, 21 – 23, 28, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Graushar (U.S. 6,347,260).

In regards to Claim 1, Graushar discloses a binding method comprising: generating a pre-personalized book on a binding line for a specific individual (Column 2, Lines 50 – 52); rejecting selective pre-personalized books (Column 2, Lines 66 – 67 → Column 3, Lines 1; and putting an alternate piece of an alternate medium compared to the pre-personalized book in place of each rejected pre-personalized book to be delivered to the specific individual (Column 3, Lines 1 – 4; Column 2, Lines 1 – 15, 50 – 67, and Column 3, Lines 1 – 4; the passages teach of a generic book [individualized medium to non individualized medium] and since it does not have the same information as a pre-personalized book it is of a different medium. Furthermore this interpretation is derived from applicant's specification where applicant states "The alternate piece may be in the form of a postcard, a book, a special interest publication or other printed media or in the form of electronic media such as a CD, e-mail message, magnetic tape, or the like" and Applicant has not defined what a "different medium" is to be considered as this

is not defined at any point in the Specification and therefore has been broadly interpreted).

In regards to Claim 3, as applied to Claim 1, Graushar further discloses wherein the pre-personalized book includes a pre-personalized signature (Column 2, Lines 50 – 55 teaches feeders 12 hold the signatures for the pre-personalized book).

In regards to Claim 4, as applied to Claim 1, Graushar further discloses wherein the act of generating the alternate piece includes printing the alternate piece off-line with respect to the binding line (Column 3, Lines 1 – 4; does not say one way or the other how the alternate piece is produced but considering how it is entered into the binding line it is inherent it is generated off the binding line).

In regards to Claim 6, as applied to Claim 1, Graushar further discloses the alternate piece is a printed product (Column 3, Lines 1 – 4).

In regards to Claim 9, Graushar discloses a binding method comprising: generating a mailing list of recipients (Column 2, Lines 1 – 15, 23 – 25, 50 – 52; the books being produced in zip code order show that there is a mailing list); generating a pre-personalized book on a binding line for a specific individual (Column 2, Lines 50 – 52); rejecting selective pre-personalized books (Column 2, Lines 66 – 67 → Column 3, Lines 1; identifying the recipient of the rejected pre-personalized book (Column 3, Line 1 – 4; it is inherent the person is identified since the individual will receive a generic book and therefore the person is identified at some point.) and putting an alternate piece that replaces the rejected pre-personalized book and notifies the recipient of the status (Column 3, Lines 1 – 4; Applicant has discussed the subscriber does not know they are

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receiving the book, however, this is not even mentioned in the claim. Therefore, as broadly claimed, it is considered the recipient can be aware of what they are going to receive).

In regards to Claim 10, as applied to Claim 9, Graushar further discloses the alternate piece is a printed product (Column 3, Lines 1 – 4).

In regards to Claim 11, as applied to Claim 9, Graushar further discloses wherein the book includes pre-personalized information (Column 3, Lines 5 - 11) and the alternate piece includes the pre-personalized information (Even though the book is generic and is put on the binding line after the printers it is inherent that there is a portion of pre-personalized information since the book is still coming to the customer at a particular address and therefore pre-personalized information is provided with the book).

In regards to Claim 13, as applied to Claim 1, Graushar further discloses wherein the act of generating the alternate piece includes printing the alternate piece off-line with respect to the binding line (Column 3, Lines 1 – 4; does not say one way or the other how the alternate piece is produced but considering how it is entered into the binding line it is inherent it is done off the binding line).

In regards to Claim 21, Graushar discloses a binding method comprising: generating a mailing list of recipients (Column 2, Lines 1 – 15, 23 – 25, 50 – 52; the books being produced in zip code order show that there is a mailing list); generating a pre-personalized printed product off-line for selected recipients on the mailing list (Column 2, Lines 50 – 55; the feeders 12 hold the signatures for the pre-personalized

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book so the signatures would be the printed product since they are created before they are in the feeders); the ability to load the pre-personalized printed products adjacent the binding line (Column 2, Lines 50 – 55; Figure 1, Items 12, 14; Applicant has failed to define a frame of reference to define the adjacent nature. The feeders, where the signatures are loaded, are on the binding line as well as the trimming stations 24. The feeders are adjacent the trimmers which are on the binding line and therefore the feeders are adjacent the binding line); assembling a book for each recipient including a respective pre-personalized printed product (Column 2, Lines 50 – 55); rejecting selective recipients' books (Column 2, Lines 66 – 67 --> Column 3, Lines 1 - 4); and generating an alternate piece in place of each rejected book (Column 3, Lines 1 - 4) the alternate piece being of a different medium than the pre-personalized printed product (Column 2, Lines 1 – 15, 50 – 67, and Column 3, Lines 1 – 4; the passages teach of a generic book and since it does not have the same information as a pre-personalized book it is of a different medium [personalized medium replaced by a non-personalized medium]. Furthermore this interpretation is derived from applicant's spec where applicant states "The alternate piece may be in the form of a postcard, a book, a special interest publication or other printed media or in the form of electronic media such as a CD, e-mail message, magnetic tape, or the like" and Applicant has not defined what a "different medium" is to be considered as this is not defined at any point in the Specification and therefore has been broadly interpreted).

In regards to Claim 22, as applied to 21, Graushar further discloses wherein the alternate piece includes at least a portion of the pre-personalized information contained

in the pre-personalized printed product for a given selected recipient (Even though the book is generic and is put on the binding line after the printers it is inherent that there is a portion of pre-personalized information since the book is still coming to the customer at a particular address and therefore pre-personalized information is provided with the book).

In regards to Claim 23, as applied to Claim 21, Graushar further discloses the act of generating a generic book to be sent to the selected recipients whose books, which were to include the pre-personalized printed products, were rejected (Column 3, Lines 1-4).

In regards to Claim 28, Graushar discloses a binding method comprising: generating a mailing list of recipients (Column 2, Lines 1 – 15); generating a pre-personalized printed product for each recipient (Column 2, Lines 50 – 52); assembling a book on a binding line for each recipient, each said book including the respective pre-personalized piece (Column 2, Lines 50 – 65; selective signatures being fed personalizes the book for the particular user); rejecting selective books (Column 2, Lines 66 – 67 → Column 3, Lines 1); removing the rejected books from respective spaces along the binding line (Column 2, Lines 66 – 67 → Column 3, Lines 1 – 4); generating an alternate pre-personalized [the generic book is present and is therefore generated at some point] piece for each recipient whose book was rejected (Column 3, Lines 1 – 4; Even though the book is generic and is put on the binding line after the printers it is inherent that there is a portion of pre-personalized information since the book is still coming to the customer at a particular address and therefore pre-

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personalized information is provided with the book), the alternate pre-personalized piece being of a different medium than the pre-personalized printed product (Column 3, Lines 1 – 4; Furthermore this interpretation is derived from applicant's spec where applicant states "The alternate piece may be in the form of a postcard, a book, a special interest publication or other printed media or in the form of electronic media such as a CD, e-mail message, magnetic tape, or the like" and Applicant has not defined what a "different medium" is to be considered as this is not defined at any point in the Specification and therefore has been broadly interpreted. It is merely a personalized medium replaced by a non-personalized medium); and inserting the alternate pre-personalized piece into the space previously occupied by the respective rejected book (Column 3, Lines 1 – 4; inserted at 27 to take over the position of the previously rejected book. The book merely takes the spot of one missing book as the bundles are just done by zip code.).

In regards to Claim 30, as applied to Claim 28, Graushar does not disclose that the alternate piece is generated on the binding line and seems to be quickly inserted to the machine during the binding process, therefore it is inherent that the alternate piece is created offline.

2. Claims 24 – 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson (U.S. 3,819,173).

In regards to Claim 24, Anderson discloses a binding method (Column 1, Lines 36 – 47) comprising: generating a pre-personalized book on a binding line for a plurality of specific individuals (Column 1, Lines 24 – 47; particular signatures for a particular

subscriber is personalizing), each pre-personalized book having therein a pre-personalized signature (Column 1, Lines 50 – 55; the card is for the particular subscriber's magazine and therefore a pre-personalized signature); rejecting selective pre-personalized books (Column 1, Lines 55 – 65); reprinting the pre-personalized signature of one of the rejected pre-personalized books (Column 1, lines 59 – 60; Anderson clearly states that upon rejection of the book the magazine is re-ordered and the a new card is punched and/or printed); and regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature (Column 1, Lines 24 – 47 teaches of the different feeders on the binding line that are used to provide signatures; Column 1, Lines 55 – 65 clearly states upon rejection that the magazine is re-ordered which inherently means that the particular signatures will be fed from the feeders and also teaches of online printing of the pre-personalized card. Furthermore it also teaches of downstream delivery of the reordered magazine which means delivery down the binding line).

In regards to Claim 25, as applied to Claim 24, Anderson further discloses wherein the step of reprinting the portion is done on the binding line (Column 1, Lines 55 – 65 teaches of reprinting the card for the reordered magazine; Column 3, Lines 15 – 24; teaches of printing a pre-personalized signature on the binding line at station 16; Figure 1, Item 16).

In regards to Claim 26, as applied to Claim 24, Anderson discloses wherein the step of printing personalized signatures is done offline with respect to the binding line and placed into feeders (Column 1, Lines 24 – 47 discloses the signatures are placed

particular feeders for a particular subscriber; Column 2, Lines 55 – 55 – 57 teaches that the signatures are placed into the feeders and from Figure 1 it is clear that the feeders are the beginning point of the binding line. Since the signatures are placed into the feeders [beginning of the binding line] it is inherent that all of the signatures are printed offline. This is further supported by the fact that the only printers in Anderson for online printing are for the inserted card [Column 3, Lines 15 – 24] and address label [Column 4, Lines 13 – 16]]. If the feeders of Anderson become empty during production more signatures would need to be reprinted and that would be inherently done offline. Therefore Anderson inherently teaches wherein the step of reprinting the portion is done offline with respect to the binding line in certain situations.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 15 – 20, and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Graushar et al. (Graushar '219; U.S. 6,694,219)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

In regards to Claim 15, Graushar '219 discloses a method of replacing a rejected book (Column 1, Lines 19 – 25) on a binding line, the method comprising: generating a mailing list of recipients having a mailing order (Column 5, Lines 12 – 14 teaches of assembly by zip code and therefore there is a master mailing list which is divided into zip codes and therefore a mailing list was generated); assembling a pre-personalized book on the binding line 10 for each recipient according to the mailing list (Column 4, Lines 9 – 23, 58 – 62; Column 5, Lines 12 – 14; Figure 1, item 10); rejecting selective pre-personalized books (Column 4, Lines 64 – 67 → Column 5, Lines 1 – 2, 23 – 25); generating an alternate piece on the binding line (Column 5, Lines 27 – 32), the alternate piece being of a format different from the rejected pre-personalized book (Column 5, Lines 27 – 32; the alternate piece can be standard, customized, personalized, or customized/personalized and therefore can have a format that is different or identical); and replacing the rejected pre-personalized book with the alternate piece, the alternate piece positioned on the binding line to maintain the mailing order (Column 5, Lines 12 – 14 teaches of assembly of books by zip codes so a reproduced book after a rejection will still go to the same zip code and maintain that order).

In regards to Claim 16, as applied to Claim 15, Graushar '219 further discloses wherein the alternate piece is a postcard (It is very well known in the art that mailed items such as books, magazines, and catalogs contain subscription and renewal cards which are postcards).

In regards to Claim 17, as applied to Claim 15, Graushar '219 further discloses wherein the pre-personalized book includes pre- personalized information (Column 4, Lines 58 – 62; Graushar '219) and the alternate piece includes the same pre-personalized information of the pre-personalized book (Column 5, Lines 30 – 32; the replacement product can be personalized/customizable and therefore allowing for any type of indicia and information; Graushar '219).

In regards to Claim 18 as applied to Claim 15, Graushar '219 modified by _ further discloses wherein the pre-personalized book includes pre- personalized information (Column 4, Lines 58 – 62; Graushar' 219) and the alternate piece includes different pre-personalized information of the pre-personalized book (Column 5, Lines 30 – 32; the product can be personalized/customizable and therefore allowing for any type of indicia and information; Graushar '219. The Examiner further considers, throughout the action, that the replacements are to be considered in its entirety).

In regards to Claim 19, as applied to Claim 15, Graushar '219 further discloses wherein the alternate piece is a printed product (Column 5, Lines 27 – 32; Graushar '219).

In regards to Claim 20, as applied to Claim 15, Graushar '219 further discloses wherein the alternate piece is in electronic format (Column 5, Lines 23 - 32; The Examiner considers the alternate piece to be both the CD and printed media; Graushar '219).

In regards to Claim 31, Graushar '219 discloses method of replacing a rejected book on a binding line, the method comprising: generating a mailing list of recipients

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(Column 5, Lines 12 – 14 teaches of assembly by zip code and therefore there is a master mailing list which is divided into zip codes and therefore a mailing list was generated); assembling a pre-personalized book on the binding line 10 for each recipient (Column 4, Lines 9 – 23, 58 – 62; Figure 1, item 10); rejecting selected pre-personalized books (Column 4, Lines 64 - 67 → Column 5, Lines 1 - 2); replacing a first rejected book with a generic book (Column 5, Lines 28 – 33; teaches the alternate piece can be standard, customized, personalized, or customized/personalized); replacing a second rejected book with a regenerated second book identical to what the second rejected book should have been (Column 5, Lines 28 – 33; teaches the alternate piece can be standard, customized, personalized, or customized/personalized and therefore the information can be identical); and replacing a third rejected book with a different medium (Column 5, Lines 28 – 33; teaches the alternate piece can be standard, customized, personalized, or customized/personalized and therefore the information can be identical. The interpretation of the different medium is derived from applicant's specification where applicant states "The alternate piece may be in the form of a postcard, a book, a special interest publication or other printed media or in the form of electronic media such as a CD, e-mail message, magnetic tape, or the like" and Applicant has not defined what a "different medium" is to be considered as this is not defined at any point in the Specification it has been broadly interpreted).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 5, 7, 8, 12, 14, and 29 are a rejected under 35 U.S.C. 103(a) as being obvious over Graushar (U.S. 6,347,260) in view of Graushar et al. (Graushar '219; U.S. 6,694,219).

Graushar '219 has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

In regards to Claim 2, as applied to Claim 1, Graushar does not disclose wherein the pre-personalized book includes pre-personalized information and the alternate piece includes the same pre-personalized information.

Graushar '219 discloses a binding method comprising: generating a pre-personalized book on a binding line for a specific individual (Column 3, Lines 64 - 65; Column 5, Lines 13 - 17; passages disclose a book can be made with this production method and the examiner considers the pre-personalized since the magazine is printed with address indicia when on the binding line); rejecting selective pre-personalized books (Column 4, Lines 64 - 67 → Column 5, Lines 1 - 5, 23 - 27); and generating an alternate piece, of an alternate medium compared to the pre-personalized book (Column 5, Lines 27 - 32; a customized/personalized replacement book can have different, less or more information and an item of different, less, more information is not the same medium since it has different information. This definition is also derived from applicant's spec wherein "The alternate piece may be in the form of a postcard, a book, a special interest publication or other printed media or in the form of electronic media such as a CD, e-mail message, magnetic tape, or the like" and Applicant has not defined what a "different medium" is to be considered as this is not defined at any point in the Specification and therefore has been broadly interpreted), in place of each rejected pre-personalized book to be delivered to the specific individual (Column 5, Lines 23 - 32; a replacement magazine is made that can be standard, personalized, customized, or personalized/customized and can therefore have the same or different information). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Graushar with the method of Graushar '219 of producing and reproducing customized/personalized books having electronic information with the feeders of personalized signatures and printers disclosed

in Graushar '219 in order to allow the recipient of the book to receive a customized book accompanied with personalized electronic information and enhance the mount and quality of the personalized printed product (Column 1, Lines 57 – 62; Column 4, Lines 58 – 62; Graushar '219).

In regards to Claim 5, Graushar does not disclose wherein the act of generating the alternate piece includes printing the alternate piece on the binding line.

Graushar '219 discloses a binding method comprising: generating a pre-personalized book on a binding line for a specific individual (Column 3, Lines 64 - 65; Column 5, Lines 13 – 17; passages disclose a book can be made with this production method and the examiner considers the pre-personalized since the magazine is printed with address indicia when on the binding line); rejecting selective pre-personalized books (Column 4, Lines 64 – 67 → Column 5, Lines 1 - 5, 23 - 27); and generating an alternate piece, of an alternate medium compared to the pre- personalized book (Column 5, Lines 27 – 32; a customized/personalized replacement book can have different, less or more information and an item of different, less, more information is not the same medium since it has different information. This definition is also derived from applicant's spec wherein "The alternate piece may be in the form of a postcard, a book, a special interest publication or other printed media or in the form of electronic media such as a CD, e-mail message, magnetic tape, or the like" and Applicant has not defined what a medium is to be considered as this is not defined at any point in the Specification and therefore has been broadly interpreted), in place of each rejected pre-personalized book to be delivered to the specific individual (Column 5, Lines 23 – 32; a

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replacement magazine is made that can be personalized) and wherein the act of generating the alternate piece includes printing the alternate piece on the binding line (Column 5, Lines 5 – 8 teaches of printing the address on the book; Column 5, Lines 25 – 30; system fabricates the replacement and therefore is on the binding line and since the entire book is fabricated again from the starting point it is inherent it goes through the quality check again and would therefore go to the printing stations following the quality check). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Graushar with the method of Graushar '219 of producing and reproducing customized/personalized books having electronic information with the feeders of personalized signatures and printers disclosed in Graushar '219 in order to allow the recipient of the book to receive a customized book accompanied with personalized electronic information and enhance the mount and quality of the personalized printed product (Column 1, Lines 57 – 62; Column 4, Lines 58 – 62; Graushar '219).

In regards to Claim 7, as applied to Claim 6, Graushar further discloses the alternate piece is a postcard (Column 1, Lines 9 – 13 teaches of mixing third class publications with second class publications; Column 1, Lines 24 – 31 teaches that second class publications are usually including editorial content and third class includes advertising material; Column 2, Lines 62 – 65 teaches that the generated book can have a postcard)

Graushar does not disclose the alternate piece is a postcard.

Graushar '219 discloses a binding method comprising: generating a pre-personalized book on a binding line for a specific individual (Column 3, Lines 64 - 65; Column 5, Lines 13 - 17; passages disclose a book can be made with this production method and the examiner considers the pre-personalized since the magazine is printed with address indicia when on the binding line); rejecting selective pre-personalized books (Column 4, Lines 64 - 67 → Column 5, Lines 1 - 5, 23 - 27); and generating an alternate piece, of an alternate medium compared to the pre-personalized book (Column 5, Lines 27 - 32; a customized/personalized replacement book can have different, less or more information and an item of different, less, more information is not the same medium since it has different information. This definition is also derived from applicant's spec wherein "The alternate piece may be in the form of a postcard, a book, a special interest publication or other printed media or in the form of electronic media such as a CD, e-mail message, magnetic tape, or the like" and Applicant has not defined what a "different medium" is to be considered as this is not defined at any point in the Specification and therefore has been broadly interpreted), in place of each rejected pre-personalized book to be delivered to the specific individual (Column 5, Lines 23 - 32; a replacement magazine is made that can be standard, personalized, customized, or personalized/customized and can therefore have the same or different information). It is also well known in the art of publications that postcards such as renewal cards or subscription cards are included with mailed publications. It is inherent that the book of Graushar '219 would have a such a postcard. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was

made to provide Graushar with the method of Graushar '219 of producing and reproducing customized/personalized books having electronic information with the feeders of personalized signatures and printers disclosed in Graushar '219 in order to allow the recipient of the book to receive a customized book accompanied with personalized electronic information and enhance the mount and quality of the personalized printed product (Column 1, Lines 57 – 62; Column 4, Lines 58 – 62; Graushar '219).

In regards to Claim 8, as applied to Claim 1, Graushar does not disclose the alternate piece is in electronic format.

Graushar '219 discloses a binding method comprising: generating a mailing list of recipients (Column 5, Lines 12 – 14 teaches of assembly by zip code and therefore there is a master mailing list which is divided into zip codes and therefore a mailing list was generated); generating a pre-personalized book with an electronic format and book for each recipient on a binding line 10 (Column 4, Lines 9 – 23, 58 – 62; Figure 1, item 10); rejecting one of the pre-personalized books (Column 4, Lines 64 – 67 → Column 5, Lines 1 – 2, 23 – 25); identifying the recipient of the rejected pre-personalized book (Column 5, Lines 27 – 30, 34 – 37); and generating an alternate piece that replaces the rejected pre-personalized book (Column 5, Lines 27 – 32), wherein the alternate piece includes a notification to the recipient regarding the status of their pre-personalized book (Column 5, Lines 27 – 32; the customizing/personalizing capability of the media fabrication allows for such a notification of status) and wherein the alternate piece is in electronic format (Column 5, Lines 23 – 32 – Graushar '219; The Examiner considers

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the alternate piece to be both the CD and printed media. Even though the CD is same, the entirety of the product is not the same as the original and therefore a different medium). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Graushar with the method of Graushar '219 of producing and reproducing customized/personalized books having electronic information with the feeders of personalized signatures and printers disclosed in Graushar '219 in order to allow the recipient of the book to receive a customized book accompanied with personalized electronic information and enhance the mount and quality of the personalized printed product (Column 1, Lines 57 – 62; Column 4, Lines 58 – 62; Graushar '219).

In regards to Claim 12, Graushar does not disclose wherein the act of generating the alternate piece includes printing the alternate piece on the binding line.

Graushar '219 discloses a binding method comprising: generating a mailing list of recipients (Column 5, Lines 12 – 14 teaches of assembly by zip code and therefore there is a master mailing list which is divided into zip codes and therefore a mailing list was generated); generating a pre-personalized book for each recipient on a binding line 10 (Column 4, Lines 9 – 23, 58 – 62; Figure 1, item 10); rejecting one of the pre-personalized books (Column 4, Lines 64 – 67 → Column 5, Lines 1 – 2, 23 – 25); identifying the recipient of the rejected pre-personalized book (Column 5, Lines 27 – 30, 34 – 37); and generating an alternate piece that replaces the rejected pre-personalized book (Column 5, Lines 27 – 32), wherein the alternate piece includes a notification to the recipient regarding the status of their pre-personalized book (Column 5, Lines 27 –

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32; the customizing/personalizing capability of the media fabrication allows for such a notification of status) and wherein the act of generating the alternate piece includes printing the alternate piece on the binding line (Column 5, Lines 5 – 8 teaches of printing the address on the book which is on the binding line – Figure 1, Item 35; Column 5, Lines 25 – 30; system fabricates the replacement and therefore is on the binding line and since the entire book is fabricated again from the starting point it is inherent it goes through the quality check again and would therefore go to the printing stations following the quality check). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Graushar with the method of Graushar '219 of producing and reproducing customized/personalized books having electronic information with the feeders of personalized signatures and printers disclosed in Graushar '219 in order to allow the recipient of the book to receive a customized book accompanied with personalized electronic information and enhance the mount and quality of the personalized printed product (Column 1, Lines 57 – 62; Column 4, Lines 58 – 62; Graushar '219).

In regards to Claim 14, as applied to Claim 9, Graushar does not disclose the alternate piece is in electronic format.

Graushar '219 discloses a binding method comprising: generating a mailing list of recipients (Column 5, Lines 12 – 14 teaches of assembly by zip code and therefore there is a master mailing list which is divided into zip codes and therefore a mailing list was generated); generating a pre-personalized book with an electronic format and book for each recipient on a binding line 10 (Column 4, Lines 9 – 23, 58 – 62; Figure 1, item

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10); rejecting one of the pre-personalized books (Column 4, Lines 64 –67 → Column 5, Lines 1 – 2, 23 – 25); identifying the recipient of the rejected pre-personalized book (Column 5, Lines 27 – 30, 34 – 37); and generating an alternate piece that replaces the rejected pre-personalized book (Column 5, Lines 27 – 32), wherein the alternate piece includes a notification to the recipient regarding the status of their pre-personalized book (Column 5, Lines 27 – 32; the customizing/personalizing capability of the media fabrication allows for such a notification of status) and wherein the alternate piece is in electronic format (Column 5, Lines 23 – 32 – Graushar '219; The Examiner considers the alternate piece to be both the CD and printed media. Even though the CD is different the entirety of the product is not the same as the original and therefore a different medium). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Graushar with the method of Graushar '219 of producing and reproducing customized/personalized books having electronic information with the feeders of personalized signatures and printers disclosed in Graushar '219 in order to allow the recipient of the book to receive a customized book accompanied with personalized electronic information and enhance the mount and quality of the personalized printed product (Column 1, Lines 57 – 62; Column 4, Lines 58 – 62; Graushar '219).

In regards to Claim 29, Gruashar does not disclose wherein generating the alternate pre-personalized piece is done on the binding line.

Graushar '219 discloses a binding method comprising: generating a mailing list of recipients (Column 5, Lines 12 – 14 teaches of assembly by zip code and therefore

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there is a master mailing list which is divided into zip codes and therefore a mailing list was generated); generating a pre-personalized printed product for each recipient; assembling a book on a binding line for each recipient (Column 4, Lines 9 – 23, 58 – 62; Figure 1, item 10), each said book including the respective pre-personalized piece (Column 4, Lines 58 - 62); rejecting selective books (Column 4, Lines 64 - 67 → Column 5, Lines 1 - 2); removing the rejected books from respective spaces along the binding line (Column 5, Lines 24 – 28); generating an alternate pre-personalized piece for each recipient whose book was rejected on the binding line (Column 5, Lines 28 – 33; the book is fabricated again and it was done on the binding line the first time), the alternate pre-personalized piece being of a different medium than the pre-personalized printed product (Column 5, Lines 28 – 33 teaches the alternate piece can be standard, customized, personalized, or customized/personalized and therefore can have a format that is different with different information and therefore being a different medium); and inserting the alternate pre-personalized piece into the space previously occupied by the respective rejected book (Column 5, Lines 12 – 14; the books are produced in zip code order and therefore the reordered magazines assume a place of the rejected magazine in the zip code bundle). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Graushar with the method of Graushar '219 of producing and reproducing customized/personalized books having electronic information with the feeders of personalized signatures and printers disclosed in Graushar '219 in order to allow the recipient of the book to receive a customized book accompanied with personalized electronic information and enhance

the mount and quality of the personalized printed product (Column 1, Lines 57 – 62; Column 4, Lines 58 – 62; Graushar '219).

Response to Arguments

Applicant's arguments with respect to claims 1 - 20, 26, 29, and 31 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed February 26, 2008 have been fully considered but they are not persuasive with respect to Claims 21 – 23, 28, and 30. Please refer to the current rejections to why the Examiner considers the alternate piece of a different medium as well as the citation to the Applicant's Specification. Also the alternate piece is generated, Applicant has not distinguished at what point in time the alternate piece is generated. Furthermore, considering that Graushar is grouped by zip code the bundle only requires the correct books to be there and no particular order but just individual spaces. The generic book fills that individual space.

Applicant's arguments filed February 26, 2008 have been fully considered but they are not persuasive with respect to Claims 24 and 25. Anderson does disclose reprinting of the pre-personalized signature at the card printer 15 at station 16 of the binding line (Column 1, Lines 55 – 65; Column 3, Lines 15 – 24). Applicant has not made it clear that all steps or regeneration (printing/reprinting, feeding, binding, trimming, quality check) are done on the binding line.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRADEEP C. BATTULA whose telephone number is (571)272-2142. The examiner can normally be reached on Mon. - Thurs. & alternating Fri. 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. C. B./
Examiner, Art Unit 3725
May 7, 2008

/Derris H Banks/

Supervisory Patent Examiner, Art Unit 3725